

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

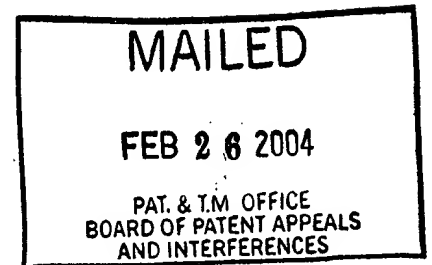
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YI-SHUNG CHAUG

Appeal No. 2002-1397
Application No. 09/310,800

ON BRIEF



Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-6, 8-10, and 19-29.

We reverse, and enter new a new ground of rejection in accordance with 37 CFR § 1.196(b).

BACKGROUND

The invention is directed to a multi-track magnetic tape head that includes "gluing vias" to increase flow of the adhesive used between surfaces of bonded portions. The "gluing vias" may be photolithographically defined and subsequently trenched to create the desired pattern.¹ Representative claim 21 is reproduced below.

21. A multi-recording element magnetic head assembly operable for at least one of reading from and writing to a multi-track medium moving across the head assembly, comprising:

a plurality of recording elements operable for at least one of reading from and writing to the multi-track medium;

a core;

at least one gluing via located between two adjacent recording elements of the plurality of recording elements, said at least one gluing via in contact with, and extending from, said core; and

an adhesive inserted into said core and said at least one gluing via.

The examiner relies on the following reference:

Tsutaki et al. (Tsukaki)	5,022,140	Jun. 11, 1991
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Claims 1, 3-6, 8-10, and 19-29 stand rejected under 35 U.S.C. § 102 as being anticipated by Tsutaki.

Claims 11-14, 16-18, and 30 have been withdrawn from consideration.

Claims 2, 7, and 15 have been canceled.

¹ We are unable to find pages 4 and 5 of the specification in the instant file wrapper. The examiner should resolve the deficiency in the file. For our understanding of the invention, we referred to the portion of the specification that is present and to the disclosure of U.S. Patent 5,943,196, which is a parent of the instant (divisional) application.

We refer to the Final Rejection (Paper No. 16) and the Examiner's Answer (Paper No. 21) for a statement of the examiner's position and to the Brief (Paper No. 20) for appellant's position with respect to the claims which stand rejected.

OPINION

Section 102 rejection of claims 1, 3-6, 8-10, and 19-29

According to the rejection of claims 1, 3-6, 8-10, and 19-29, Tsutaki shows (Figs. 3A-3F) a multiple recording/reproducing head block structure that, prior to being cut into single-element heads, anticipates the claimed invention. (Final Rejection at 3.) Appellant responds (Brief at 3-4) that the reference does not teach a multi-recording element head assembly that is operable for either reading or writing to a medium, as claimed. In appellant's view, the intermediate structure shown in Figures 3A through 3F of Tsutaki is not so operable.

The examiner responds (Answer at 3-4) that all the independent claims use the term "operable," but as a statement of intended use. The examiner acknowledges that the relevant structures in Tsutaki are ultimately divided into single-element heads, as indicated in Figure 4G. However, the examiner finds that the structure shown in Figure 3E of Tsutaki is operable to record/reproduce multiple tracks, disagreeing with appellant's argument that adjoining structures would short one another out.

Instant, representative claim 21 recites a "plurality of recording elements operable for at least one of reading from and writing to...." The language, in isolation,

could represent a statement of intended use, and read on the intermediate structures taught by Tsutaki, which are ultimately divided into single-element heads operable for reading from, and writing to, magnetic media. However, claim 21 recites that the recording elements are operable with respect to "the multi-track medium." The preamble of claim 21 recites, "[a] multi-recording element magnetic head assembly operable for at least one of reading from and writing to a multi-track medium moving across the head assembly...." Although the "multi-track medium" is not a structural limitation of the claim -- the recitation, instead, serves to further limit the recording elements that are positively recited -- the body of the claim relies on the preamble for antecedent.

A claim preamble has the import that the claim as a whole suggests for it. Bell Communications Research, Inc., v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). In our view, the preamble of instant claim 21 is a limitation, rather than a statement of intended use. We thus hold that the scope of the claim is limited to a multi-recording element magnetic head assembly operable for at least one of reading from and writing to a multi-track medium moving across the head assembly. For similar reasons, the remainder of the independent claims -- 1, 6,

27, and 29² -- are also limited to operable multi-recording element magnetic head assemblies.

Thus, under what we consider to be the proper interpretation of the independent claims, we agree with appellant that Tsutaki fails to anticipate the instant invention.

The examiner points to no support in the reference for the position that the structure shown in Figure 3E "is operable to record/reproduce multiple tracks." Nor do we find any such indication in the reference. Since Tsutaki does not expressly support the examiner's position, the finding is necessarily based on a theory of inherency. With respect to what may be "inherent," however, our reviewing court has set out clear standards for such a showing. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Absent evidence in support of a finding by the examiner that is disputed by appellant, the rejection must fail.

Since the examiner has not shown any of the independent claims to be met by the reference, we do not sustain the rejection of claims 1, 3-6, 8-10, and 19-29 under 35 U.S.C. § 102 as being anticipated by Tsutaki.

² Claim 29, a product-by-process claim that incorporates the method of claim 11, is independent because it is in a different statutory class from claim 11. The subject matter of claim 19 is not understood, and is subject to a new ground of rejection, infra.

Claim 19 -- new ground of rejection

We enter the following new ground of rejection in accordance with 37 CFR § 1.196(b): Claim 19 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. In re Vamco Mach., Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 635 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Instant claim 19 purports "[t]he multi-recording element magnetic head assembly of Claim 1 [an apparatus] formed in accordance with the method of Claim 11 [a process]." The subject matter of claim 19 cannot be ascertained, at least for the reason that same or similar structures are described by claim 1 and claim 11. For example,

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claim 1 recites "a substrate" and "a thin film layer deposited on a substantially planar surface of said substrate." Claim 11 recites "forming a thin film layer on a substantially planar substrate." The invention of claim 19 thus appears to be defined by one or two thin film layers, with at least one layer deposited on a substantially planar surface of a substrate and at least one layer formed on a substantially planar substrate; i.e., one or two layers on one or two substrates. The recitation of similar structures in claims 1 and 11, without antecedent reference with respect to one or the other of the similar structures, renders the subject matter of claim 19 indeterminate.

CONCLUSION

The rejection of claims 1, 3-6, 8-10, and 19-29 under 35 U.S.C. § 102 is reversed.

Claim 19 is newly rejected by us under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

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(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR 1.196(b)

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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